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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,143	12/02/2003	David K. Swanson	03-0312 (US01)	5314

41696 7590 02/01/2007  
VISTA IP LAW GROUP LLP  
12930 Saratoga Avenue  
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EXAMINER
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ROANE, AARON F

ART UNIT	PAPER NUMBER
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3739

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/01/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

8

<b>Office Action Summary</b>	<b>Application No.</b> 10/727,143	<b>Applicant(s)</b> SWANSON, DAVID K.	
	<b>Examiner</b> Aaron Roane	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 November 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 27-50 is/are pending in the application.
- 4a) Of the above claim(s) 7, 37 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-10, 27-36 and 39-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/13/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8-10, 27-29 and 31-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Sherman et al. (USPN 6,010,500).

Regarding claims 1, 27 and 47, Sherman et al. disclose a source of coagulation energy (29); a source of stimulation energy (inherent); and a surgical probe (10), adapted to be operably connected to the source of coagulation energy and the source of stimulation energy, including a relatively short shaft (ranging from a point proximal of the most proximal 32 to the distal end of 12) defining a distal region and a proximal region; a coagulation element (coagulation means) (18) defining a coagulation element configuration on the distal region of the relatively short shaft; and a stimulation element

(stimulation means) defining stimulation element (38a and 38b) configuration on the distal region of the relatively short shaft, the stimulation element configuration being different than the coagulation element configuration, see col. 3, line 66 through col. 7, line 38 and figures 1-6.

Regarding claims 2-6 and 31-34, Sherman disclose the claimed invention, see col. 3, line 66 through col. 7, line 38 and figures 1-6.

Regarding claims 8, 35 and 48, Sherman et al. disclose an embodiment wherein the relatively short shaft is malleable, see col. 8, line 21 through col. 9, line 14 and figures 14-17D.

Regarding claims 9 and 49, Sherman et al. further disclose a handle (portion adjacent 24 and 27) associated with the proximal region of the relatively short shaft, see figure 1.

Regarding claims 10 and 50, Sherman et al. further disclose the stimulation element is located distally of the coagulation element, see element 38a in figures 5 and 6.

Regarding claim 28, Sherman et al. further disclose a coagulation energy line (26) connected to the coagulation element and to a coagulation energy connector (27) configured to be connected to the source of coagulation energy; and a stimulation energy line (inherent) connected to the stimulation element and to a stimulation energy connector

(inherent) configured to be connected to the source of stimulation energy, see col. 3, line 66 though col. 7, line 38 and figures 1-6.

Regarding claim 29, Sherman et al. disclose the claimed invention, see col. 3, line 66 though col. 7, line 38 and figures 1-6.

Regarding claim 36, Sherman et al. disclose the claimed invention, see col. 7, lines 4-38.

Regarding claims 39 and 43, Sherman et al. further disclose the coagulation element and the stimulation element are carried on the relatively short shaft such that the coagulation element and the stimulation element longitudinally fixed relative to one another, see col. 3, line 66 though col. 7, line 38 and figures 1-6 and claims 10-12.

Regarding claims 40-42 and 44-46, Sherman et al. disclose the claimed invention, see col. 3, line 66 though col. 7, line 38 and figures 1-6.

Claims 1, 27, 28, 30, 39 and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Hooven (USPN 6,889,694).

Regarding claims 1 and 27, Hooven discloses a source of coagulation energy (114); a source of stimulation energy (inherent); and a surgical probe (110), adapted to be operably connected to the source of coagulation energy and the source of stimulation

energy, including a relatively short shaft (116) defining a distal region and a proximal region, a coagulation element (120) defining a coagulation element configuration on the distal region of the relatively short shaft, and a stimulation element (172) defining a stimulation element configuration on the distal region of the relatively short shaft, the stimulation element configuration being different than the coagulation element configuration, see col. 11, line 14 through col. 14, line 48 and col. 15, lines 27 through col. 16, line 6 and figures 33-51 and 66.

Regarding claim 28, Hooven further discloses a coagulation energy line (within 112) connected to the coagulation element and to a coagulation energy connector (part of proximal connector of 112 that has a mating structure on 114) configured to be connected to the source of coagulation energy; and a stimulation energy line (within 112) connected to the stimulation element and to a stimulation energy connector (part of proximal connector of 112 that has a mating structure on 114) configured to be connected to the source of stimulation energy, see col. 11, line 14 through col. 14, line 48 and col. 15, lines 27 through col. 16, line 6 and figures 33-51 and 66.

Regarding claim 30, Hooven further discloses a handle (140) associated with the proximal region of the relatively short shaft; wherein the coagulation energy connector is carried by the handle and the stimulation energy line extends through the handle, see figure 33.

Art Unit: 3739

Regarding claims 39 and 43, Hooven further discloses the coagulation element and the stimulation element are carried on the relatively short shaft such that the coagulation element and the stimulation element longitudinally fixed relative to one another, see figure 66.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-6, 8-10 and 27-36 have been considered but are moot in view of the new ground(s) of rejection. Due to the addition of new claims containing new claimed subject matter, new prior has been supplied.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

Art Unit: 3739

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aaron Roane  
January 24, 2007

*A.R.*

*Roy D. Gibson*  
ROY D. GIBSON  
PRIMARY EXAMINER